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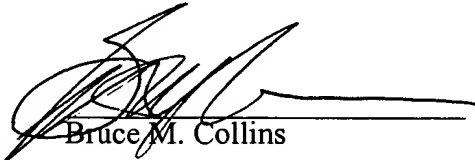
"CERTIFICATE OF MAILING"

Date of Deposit: November 22, 2004

Type of Documents:

1. Acknowledgment Post Card;
2. "Certificate of Mailing;
3. Petition to the Commissioner Under 37 CFR §1.181 and 1.182;
4. Declaration of Gloria A. Cherry Accompanying Petition to the Commissioner Under 37 CFR §1.181; and
5. Declaration of Bruce M. Collins Petition to the Commissioner Under 37 CFR §1.181

I hereby certify that this paper and fee are being deposited with the United States Postal Service's "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated above and is addressed to Mail Stop: Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Bruce M. Collins



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of GREGORY :

Serial No. 08/087,132 :

Filed: July 2, 1993 :

For: NEW DIAGNOSTIC AND TREATMENT :
METHODS INVOLVING THE CYSTIC :
FIBROSIS TRANSMEMBRANE REGULATOR :

Group Art Unit: 1814
Examiner: K. C. Carlson, Ph.D.
Customer No.: 26817

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
SIR:

PETITION TO THE COMMISSIONER UNDER 37 CFR §1.181 AND 1.182

ACTION REQUESTED

Applicant respectfully petitions the Commissioner to withdraw and/or rescind the Notice of Abandonment mailed November 16, 2004. This petition is accompanied by the supporting declarations of the undersigned and Mrs. Gloria Cherry.

Under the unique circumstances herein involved, it is not believed that 37 CFR § 1.137 (a) or (b) are applicable since there is no "delay in reply". The inadvertent abandonment occurred, and this petition is being filed, well within the statutory period for response. Remedial steps were initiated within one business day of the discovery of the error.

Moreover, it is not clear whether relief and the proper remedy lie under 37 CFR § 1.181(a) (1) or (3) or 37 CFR § 1.182, whether any fees are due, and if so, what those fees should be. The holding of abandonment technically is an

action by the examiner but it is believed to have resulted from ministerial action and not from any direct or unauthorized action by the Examiner. The exercise of supervisory action is requested but at the same time, it does not appear this is a situation specifically addressed by the rules.

Accordingly, authority is hereby given to charge any fees which the Commissioner deems due to Deposit Account No. 13-2165.

Finally since this application has been pending for over a decade, expedited handling is respectfully requested.

STATEMENT OF FACTS INVOLVED

This application was involved in Interference No. 103,933 which was resolved in Applicant's favor.¹

Ex parte prosecution was resumed in May of 2004 and the claims were finally rejected on October 14, 2004. There were three bases for the final rejection, one of which included a double patenting rejection over claims 19, 20 and 21 of copending application No. 08/311,665.

On November 4, 2004, counsel conferred telephonically with the Examiner, Dr. K. C. Carlson, concerning the outstanding Official Action. During that conference, counsel proposed that to bring this application into condition for allowance, (i) non-elected subject matter would be cancelled, (ii) claim 228 would be amended to overcome a rejection under 35 USC § 112, and (iii) the double patenting rejection would be overcome by re-asserting the subject matter of claims 19, 20 and 21 in No. 08/311,665 as new claims in this application, whereupon No. 08/311,665 would be expressly abandoned and thereby render the double patenting rejection moot. Dr. Carlson advised counsel that these actions were

¹ The decision was affirmed by the Court of Appeals for the Federal Circuit.

acceptable and appeared to overcome the all grounds of rejection, obviously withholding a final decision until such time as the papers were filed.

An Amendment which effected the agreed-upon course of action was filed in this application the next day, November 5, 2004 (COM). At the same time, counsel filed what he thought was an express abandonment of No. 08/311,665, thereby complying with all the points of agreement reached with the Examiner.

As shown on the accompanying Declarations of Gloria A. Cherry and Bruce M. Collins, however, the abandonment that was submitted inadvertently carried the caption for this application rather than that of No. 08/311,665. The error was entirely one of human origin on the part of counsel's secretary, compounded by counsel's failure to re-examine the caption on a revised document.²

The Examiner was contacted the next business day, November 8, 2004, and advised of the error. In accordance with her instructions, a communication explaining the inadvertency and requesting that Express Abandonment filed November 5, 2004 be disregarded was filed that day by fax.

On November 19, 2004, two weeks later, a Notice of Abandonment was received which indicated that to the contrary and based on the express abandonment, this application was abandoned.

This Petition follows on the next business day.

² Ironically, Mrs. Cherry used the correct caption on an abandonment form that she first prepared, the error in the caption arising only when, at counsel's request, she discarded that form and revised the body of the document.

REASONS WHY RELIEF SHOULD BE GRANTED

Mrs. Cherry's Declaration and the undersigned's Declaration detail how the error arose. Indeed it is apparent from the very papers that were filed on November 5, 2004 that an error had occurred.

First, no claim numbered 19, 20 or 21 is currently pending in this application. Consequently subject matter identified in the abandonment is not even present in this application. The reference to claims 19, 20 and 21 thus makes no sense if 08/087,132 were to be abandoned; it makes perfect sense if 08/311,665 is the application to be abandoned.

Second, an Amendment was concurrently filed in this application. This too would be nonsensical if this application were being abandoned, particularly since that Amendment on its face would have placed the application in condition for allowance. On the other hand, the amendment in this case is perfectly consistent with continued prosecution if 08/311,665 were the application being abandoned.

Third, there was specific reference in the Abandonment to the reassertion in this application, No. 08/087,132, of the subject matter of claims 19, 20 and 21 of No. 08/311,665. Such a "reassertion" of course would be impossible if Serial No. 08/087,132 were abandoned.

Fourth, while carrying the same captions, the Express Abandonment carried both counsel's and the client's docket numbers for Serial No. 08/311,665 (Firm Docket No. "4155-105", Client Docket No. "IG4-09.14US") whereas the Amendment here carried docket numbers for Serial No. 08/087,132 (Firm Docket No. "4155-102", Client Docket No. "IG4-09.2-FWC") . {See Mrs. Cherry's Declaration, ¶¶ 3 and 6}. Clearly the Amendment and Abandonment were intended for separate applications.

Finally while the abandonment of Serial No. 08/311,665 had been specifically discussed and agreed upon during the telephone conference between Dr.

Carlson and the undersigned on November 4, 2004, there was absolutely no discussion of abandoning this application. Conversely, while amendments to this application were discussed with the Examiner, specifically the cancellation of non-elected subject matter and the amendment of claim 228 to overcome a rejection under 35 USC § 112, not only was no discussion devoted to amendments in Serial No. 08/311,665, such amendments would be pointless (since there was no non-elected subject matter and no claim 228 in Serial No. 08/311,665).

The abandonment thus indisputably arose from simple human error, the simple erroneous "paste" of the wrong caption. As noted, this application has been pending for over a decade and has been accorded the benefit of an application filed nearly fifteen years ago. Literally tens if not hundreds of thousands of dollars have been spent during the interference and subsequent appeal. Clearly there was no intent to "abandon" this application.

Upon the granting of this petition, an express abandonment for 08/311,665 will be immediately filed.

Accordingly, it is respectfully requested that this petition should be granted and the holding of abandonment be rescinded.

Respectfully submitted,

By: 

Bruce M. Collins

Reg. No. 20,066

Mathews, Collins, Shepherd & McKay, P.A.

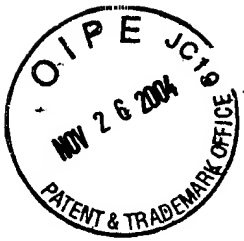
100 Thanet Circle, Suite 306

Princeton, New Jersey 08540

Phone: (609) 924-8555

Fax: (6109) 924-3036

Date: November 22, 2004



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of GREGORY :

Serial No. 08/087,132 :

Filed: July 2, 1993 :

For: NEW DIAGNOSTIC AND TREATMENT :
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Group Art Unit: 1814

Examiner: K. C. Carlson, Ph.D.

Customer No.: 26817

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
SIR:

***DECLARATION ACCOMPANYING
PETITION TO THE COMMISSIONER UNDER 37 CFR §1.181***

I, Gloria A. Cherry, hereby declare that:

1. All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

2. I have been an employee of Mathews, Collins, Shepherd & McKay, P.A., 100 Thanet Circle, Princeton, NJ, working with Bruce M. Collins, Counsel to the Firm, since March of 2002. I go by my nickname, Mickey, and "MC" thus appears on documents I have initialed.

3. On or about November 5, 2004, I prepared an Amendment Under 37 CFR §1.116 in application No. 08/087,132. This application carries the Firm Docket No. "4155-102" and a Client Docket No. "IG4-09.2-FWC"

4. At that time, I was aware Mr. Collins had conferred with the Examiner, Dr. K. C. Carlson, the previous day concerning an Official Action dated October 14, 2004. It was my understanding from conversations with Mr. Collins that during that conference, Dr. Carlson had agreed the application would be placed in condition for allowance if (i) non-elected subject matter was cancelled, (ii) an amendment to the language of claim 228 was made, and (iii) a double patenting rejection over copending application No. 08/311,665 was overcome.

5. Mr. Collins prepared a draft of an amendment on November 4 and 5, 2004 which on November 5, 2004, I prepared in final form. I gave the document I had finalized to Mr. Collins for signature, physically affixed postage to an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450", and placed the envelope carrying the signed Amendment in the Firm's outgoing mail box on the same day. The mailing was accompanied by a return receipt post card.

6. Also on November 5, 2004, and concurrently with preparation of the Amendment in No. 08/087,132, Mr. Collins asked me to prepare an Express Abandonment in application No. 08/311,665. This latter application has the same inventor but carries the Firm Docket No. "4155-105" and a Client Docket No. "IG4-09.14US". I prepared a draft of what I thought was an appropriate form utilizing the "IP Legal" Forms Manager and gave it to Mr. Collins for review and signature.

7. Mr. Collins reviewed the entire document but he concluded that the language of the preprinted form I had selected could not be used. Mr. Collins wrote out revised language and I prepared a new Express Abandonment using

that language. Because a standard form could not be used, I typed this as a new document. I thereafter gave it to Mr. Collins for signature and then physically affixed postage to an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" and placed the envelope carrying the signed Express Abandonment in the Firm's outgoing mail box on November 5, 2004. This mailing was also accompanied by a return receipt post card.

8. The Firm's standard procedure requires that photocopies of return receipt post cards accompanying any response be given to the Firm's Docket Manager in order to advise him of what action had been taken. I did this at about the time I placed the two envelopes in the outgoing mail box.

9. It is customary that between approximately 5:00 and 5:30 PM, all Firm mail is physically delivered to the United States Post Office in Princeton, NJ. On November 5, 2004, the Firm's mail including both envelopes was taken to the United States Post Office by another employee at approximately 5:10 PM.

10. Approximately thirty minutes thereafter, the Docket Manager called my attention to the fact that while the copies of the return receipt post cards I had given him showed different docket numbers, both carried the same serial number. By this time, Mr. Collins had left for the day.

9. Upon investigation, I determined that when I retyped the abandonment, I inadvertently introduced the caption information associated with application No. 08/087,132, which I have saved in my computer's memory, rather than using the caption information associated with application No. 08/311,665 which I had used with the preprinted form.

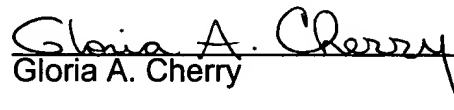
10. Mr. Collins was not expected in the office on Monday, November 8, 2004. I therefore immediately contacted Dr. Carlson who advised me to send in an explanation by fax. I also contacted Mr. Collins, explaining what had happened. Mr. Collins stated he would come into the office, which he did. He

immediately prepared a "Communication" explaining what had occurred. He signed this and I faxed it to Dr. Carlson the same day.

11. On November 19, 2004, the Firm received a "Notice of Abandonment" in application No. 08/087,132.

12. The "abandonment" of application No. 08/087,132 was not intended and was caused entirely by my inadvertent error in typing the wrong caption of the document.

Date: November 22, 2004


Gloria A. Cherry



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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METHODS INVOLVING THE CYSTIC :
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Group Art Unit: 1814

Examiner: K. C. Carlson, Ph.D.

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
SIR:

***DECLARATION ACCOMPANYING
PETITION TO THE COMMISSIONER UNDER 37 CFR §1.181***

I, Bruce M. Collins, hereby declare that:

1. All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

2. I am counsel to the Firm of Mathews, Collins, Shepherd & McKay, P.A., 100 Thanet Circle, Princeton, NJ, and an attorney of record in this application. Mrs. Cherry has worked with me since March of 2002.

3. On November 4, 2004, I conferred telephonically with the Examiner, Dr. K. C. Carlson, concerning an Official Action dated October 14, 2004. During that conference, I proposed, and Dr. Carlson agreed, that (i) non-elected subject matter would

be cancelled, (ii) an amendment to the language of claim 228 would be made, and (iii) a double patenting rejection over copending application No. 08/311,665 would be rendered moot by abandoning that application and reasserting the subject matter of its three claims in this application.

3. I thereupon drafted an Amendment Under 37 CFR §1.116 in this application (which carries the Firm Docket No. "4155-102" and a Client Docket No. "IG4-09.2-FWC").

4. Mrs. Cherry finalized the document and gave it to me for signature.

5. Concurrently with preparation of the amendment on November 5, 2004, I asked Mrs. Cherry to prepare an Express Abandonment for my signature in application No. 08/311,665. Originally I thought a standard form such as those in the "IP Legal" Forms Manager could be used. Mrs. Cherry filled out what she thought was an appropriate form and gave it to me.

6. I reviewed the entire document, including the caption. The caption was correct but I concluded that the language of a standard preprinted form could not be used in this situation. Accordingly, I wrote out revised language in longhand and gave it to Mrs. Cherry, asking her to prepare a new Express Abandonment using my language.


7. Upon review I found the language suitable. In this review, however, I did not check the caption again, assuming since it was generated by word processing that it was the same as that on the previous form I had reviewed. At the time, I did not realize Mrs. Cherry had not worked from the form but made up the entire document "from scratch"; *i.e.*, she had "pasted" in the caption as well as typing in my language for the body of the abandonment. In doing so, she had inadvertently introduced the caption of this case, rather than carrying over the caption for No. 08/311,665.

8. I signed the document on November 5, 2004 and instructed Mrs. Cherry to mail it and the Amendment to the PTO. As noted, I did not re-check the caption

since I assumed it was the same as on the first form I had seen. I was not aware of the error until Monday, November 8, when Mrs. Cherry advised me telephonically that the Abandonment had carried the wrong caption. I immediately cancelled my prior plans and returned to the office where prepared a "Communication" explaining what had occurred. I signed this and Mrs. Cherry faxed it to Dr. Carlson the same day.

9. I was today informed that on November 19, 2004, the Firm had received a notice of abandonment of this application.

10. The "abandonment" of application No. 08/087,132 was not intended by me or by the client and arose solely by reason of the error detailed above.



Bruce M. Collins

Date: November 22, 2004